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AUG 13 2003

OFFICE OF PETITIONS

In re Application of
Kalnitsky & Lin
Application No.: 09/998,595
Filed: November 16, 2001
Attorney Docket No.: 93-C-032RE(1678-42)
For: ENHANCED PLANARIZATION
TECHNIQUE FOR AN INTEGRATED CIRCUIT

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed July 30, 2002 (certificate of mailing date July 22, 2002).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

The above-identified application was filed on November 16, 2001 without an executed oath or declaration. On February 21, 2002, a Notice to File Missing Parts of Reissue Application was mailed. This Notice required petitioner to file an executed declaration, a statement from the assignee establishing ownership of the reissue application, filing fees, and a surcharge within two months of the February 21, 2002 mail date of the Notice.

In response, petitioner filed a request for a three month extension of time and required fee, filing fees, the surcharge, a statement of ownership from the assignee, the instant petition and petition fee on July 30, 2002 (certificate of mailing date July 22, 2002). A statement of facts authored by Attorney Bryan A. Santarelli and a declaration of Mary L. Hiner accompanies the petition. Ms. Hiner, patent assistant to the assignee, states that she called non-signing inventor Lin's last known phone number and reached who she believed to be Mr. Lin's wife. Mr. Lin's wife gave her a number for Mr. Lin's cell phone. She then called Mr. Lin's cell phone number and spoke to Mr. Lin. Mr. Lin stated requested that Ms. Hiner call later. Ms. Hiner did so and left a message for Mr. Lin. Mr. Lin didn't return the call. Mr. Lin did not return another phone message left by Ms. Hiner. In addition, Mr. Lin's last known e-mail address is not functional.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2) above.

As to item (1), Applicants have failed to establish that the non-signing inventor, Yih-Shung Lin, cannot be located.

A showing of **diligence** is critical in obtaining Rule 47 status when an inventor cannot be located or reached. Unanswered phone messages does not meet the required level of diligence that must be shown in order to obtain Rule 47 status.

Petitioner should engage in further efforts to locate Mr. Lin. The following is a list of evidentiary sources that are commonly relied upon to prove inability to locate an inventor: searches of Internet databases; inquiries of local telephone directories; inquiries of any extant national or regional registries, telegrams; and documented inquiries of last known employers. Every listed type of search need not be done. However, a diligent effort to find the inventor must be made. Petitioner may wish to contact Mrs. Lin again in order to obtain a home address for Mr. Lin.

Documentary evidence that supports a finding that the non-signing inventor could not be found or reached should be made part of any affidavits or declarations that fully describe the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventor. Printed computer records would suffice.

The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The citizenship of each inventor must be included on the oath or declaration. There is no citizenship listed for Mr. Lin. As listing the citizenship for each inventor is a statutory requirement under 35 USC 115, it cannot be waived. Mr. Kalnitsky must execute another declaration that lists Mr. Lin's full information, including citizenship. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of the non-signing inventors is REQUIRED. See MPEP 409.03(a).

Further correspondence with respect to this matter should be addressed as follows:

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